

REMARKS

In a Final Office Action mailed February 13, 2006, claims 2, 6, 9, 10, 11, 14, 16, 20 and 21 were rejected under 35 U.S.C. §112, second paragraph; claims 1-4, 6-8, 10-11 and 13-21 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter; claims 1, 4, 6, 8, 10, 11, 13-15 and 18-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Szlam in view of White; claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Szlam in view of White and further in view of Hamscher; and claims 2, 3, 7 and 16 appear to have been rejected under 35 U.S.C. §103(a) as being unpatentable over Szlam in view of White and further in view of Hamscher in view of Makuch. Additionally, claims 1-4, 6-8, 10, 15 and 18-21 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 5-7 of co-pending U.S. Patent Application No. 10/011523 in view of Szlam; and claims 1, 3, 4, 6-8, 10, 15 and 18-21 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of co-pending U.S. Patent Application No. 10/200262 in view of Szlam. Applicants respectfully traverse and request reconsideration.

As an initial matter, Applicants note that claims 6, 8, 10, 11, 13, 14, and 19-21 have been canceled above, in addition to previously canceled claims 5, 9 and 12. Thus, no further discussion concerning claims 5, 6, 8-14 and 19-21 will be presented. Furthermore, the specification has been amended above to correct various typographical errors.

Claims 2, 6, 9, 10, 11, 14, 16, 20 and 21 stand rejected under 35 U.S.C. §112, second paragraph as including the following allegedly vague and indefinite recitation:

“value the ability”, “concerned”, “aggressive”, “tactics” and “allocation of available collection resources.” Applicants note that claim 9 has been previously canceled, thereby render the rejection of claim 9 moot. Furthermore, claims 6, 10, 11, 14, 20 and 21 have been canceled above, thereby rendering the rejection of these claims moot. Further still, with regard to claims 2 and 16, Applicants note that none of the cited recitations appear in any of the claims, either prior to or after the amendments to the claims above. Therefore, Applicants respectfully submit that claims 2 and 16 are in suitable condition for allowance.

Claims 1-4, 6-8, 10-11 and 13-21 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter for failure to state a “technological basis” in the preamble and/or body of the cited claims. In support of this rejection, citation is made to *Ex parte Bowman*, a non-precedential (and therefore non-binding) Board opinion. Furthermore, in an extensive explanation, the Examiner further supported this rejection by citing the so-called “technological arts” test for statutory subject matter developed by *In re Musgrave* and its progeny, *In re Toma* and *Ex parte Bowman*.

However, Applicants note that the presently asserted “technological basis” test and the “technological arts” test cited to support it, are not proper bases for rejection under 35 U.S.C. § 101. Recently, in the “Interim Guidelines For Examination of Patent Applications For Patent Subject Matter Eligibility” (1300 O.G. 142, November 22, 2005) (hereinafter “Interim Guidelines”), the Office has set forth guidelines to assist in the determination “whether a claimed invention falls within a judicial exception to statutory subject matter (i.e., is nothing more than an abstract idea, law of nature, or natural phenomenon), or whether it is a practical application of a judicial exception to statutory

subject matter.” The Interim Guidelines first note the “wide scope” of subject matter eligibility established by § 101, quoting from the Federal Circuit’s decision in *In re Alappat*, 33 F.3d 1526, 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994) (en banc):

The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35 . . . Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations. (Interim Guidelines, § IV(A), para. 7)

Thus, subject matter eligibility under § 101 is to be viewed broadly and inclusively. After noting the explicit limits set forth in § 101 (any new and useful machine, manufacture, composition of matter or process), the Interim Guidelines further note the judicial exceptions to subject matter eligibility: abstract ideas, laws of nature and natural phenomena. (Interim Guidelines, § IV(A), para. 10) However, even claims that employ these judicial exceptions may constitute patentable subject matter to the extent that they comprise practical applications or uses thereof. (Interim Guidelines, § IV(C), para. 3) Furthermore, in deciding whether a claim that includes one of judicial exceptions encompasses a “practical application”:

the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." (Interim Guidelines, § IV(C)(2)(b))

With this as the background, the Interim Guidelines further recite specific subject matter eligibility tests that are *not* to be used. In this regard, Applicants make particular note of Annex III (entitled "Improper Tests For Subject Matter Eligibility"), § (a), para. 1 of the Interim Guidelines, where it is stated:

United States patent law does not support the application of a "technical aspect" or "technological arts" requirement. Title 35 of the United States Code does not recite, explicitly or implicitly, that inventions must be within the "technological arts" to be patentable. Section 101 of Title 35 recites that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor" Accordingly, while an invention must be "new" and "useful," there is no statutory requirement that it fit within a category of "technological arts." Moreover, although there has been some judicial discussion of the expression "technological arts" and its relationship to patentability, this dialogue has been rather limited and its viability is questioned.

Citing recent precedent, the Interim Guidelines further elaborate:

In *Ex parte Lundgren*, Appeal No. 2003-2088, Application 08/093,516, (Precedential BPAI opinion September 2005), the Board rejected the examiner's argument that Musgrave and Toma created a technological arts test. "We do not believe the court could have been any clearer in rejecting the theory the present examiner now advances in this case." *Lundgren*, at 8. The Board held that "there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under Sec. 101." (Interim Guidelines, Annex III, § IV(a), para. 7)

Finally, the Interim Guidelines instruct:

USPTO personnel should no longer rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter. There is no other recognized exceptions to eligible subject matter other than laws of nature, natural phenomena, and abstract ideas. (Interim Guidelines, Annex III, § IV(a), para. 8)

As a result, Applicants respectfully submit that the current rejection under 35 U.S.C. § 101 is improper and request withdrawal of the rejection and removal of the finality of the instant Office Action pursuant to M.P.E.P. §§ 706.07(d) or (e). Furthermore, Applicants respectfully submit that the instant claims, as currently amended, constitute patentable subject matter to the extent that they fall within one of the statutory classes of patent subject matter (e.g., new and useful processes and machines). Even assuming, solely for the sake of argument, that the instant claims somehow embrace abstract ideas, Applicants further submit that the claims recite a “useful, tangible and concrete” result. For example, instant claim 1 recite the useful, tangible and concrete result of assigning a debt collection strategy to a debtor. Should the Examiner persist in the rejection of the claims under 35 U.S.C. § 101, Applicants note that “[t]he burden is on the USPTO to set forth a prima facie case of unpatentability” (Interim Guidelines, § IV(B), para. 5), and that if any such rejection is to be maintained, a subsequent Office Action “should clearly communicate the findings, conclusions and reasons which support [it].” (Interim Guidelines, § VII)

Claims 1, 4, 6, 8, 10, 11, 13-15 and 18-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Szlam in view of White. As noted above, claims 6, 8, 10, 11, 13, 14 and 19-21 have been canceled above, thereby rendering the rejection of these claims moot. Applicants further note that claims 1 and 15 have been amended above to recite the limitation that each of the attitudinal segments corresponds to a group of debtors having similar responses to different debt collection strategies. Support for this amendment may be found at least in paragraphs [0034] – [0036]. Applicants respectfully submit that Szlam and White, either separately or in combination, fail to teach attitudinal

segments corresponding to groups of debtors having similar responses to different debt collection strategies. As such, Applicants respectfully submit that Szlam in view of White fails to establish prima facie obviousness of claims 1 and 15, which claims are therefore in suitable condition for allowance. Furthermore, with regard to claims 2-4, 7, 16 and 17, which depend from claims 1 and 15, respectively, these claim are believed to be allowable on their merits and at least due to their dependency on independent claims 1 and 15.

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Szlam in view of White and further in view of Hamscher. Currently amended claim 17 depends from claim 15. As described above, the combination of Szlam in view of White fails to establish prima facie obviousness of claim 15 for failing to teach all of the limitations of claim 15. Applicants respectfully submit that this shortcoming of the combination of Szlam in view of White is not remedied by the further application of Hamscher. Furthermore, the limitation that Hamscher has been alleged to teach, i.e., “negotiation scripts”, is no longer found in amended claim 17, thereby rendering the application of Hamscher moot. Thus, claim 17 is believed to be allowable on its merits and at least due to its dependency on independent claim 15.

Claims 2, 3, 7 and 16 appear to stand rejected under 35 U.S.C. §103(a) as being unpatentable over Szlam in view of White and further in view of Hamscher in view of Makuch. Applicants note that Section 9 of the “Detailed Action” of the Office Action begins by stating that claims 2, 7 and 16 are rejected based on Szlam in view of White and further in view of Makuch. Without further comment on the combination of Szlam in view of White and further in view of Makuch as applied to claims 2, 7 and 16, the

rejection continues by stating that claim 3 is rejected based on the combination of Szlam in view of White and further in view of Hamscher in view of Makuch. Thus, Section 9 of the “Detailed Action” appears to be combining two different bases of rejection of two different sets of claims. Further adding to Applicants’ confusion, the sole explanation of either of the rejections, which appears to be focused on the latter rejection, states that the combination of Szlam in view of White and further in view of Hamscher in view of Makuch states:

Szlam et al., White et al., and Hamscher do not specifically disclose segments that include debtors who value the ability to restructure debt payment or debtors who are concerned about credit rating.

Makuch is then cited as teaching the missing limitation. However, Applicants note that none of claims 2, 3, 7 or 16 included the cited limitation of “segments that include debtors who value the ability to restructure debt payment or debtors who are concerned about credit rating” at the time the instant Office Action was mailed, nor do any of the current amendments to claims 2, 3, 7 or 16 add the cited limitation to the claims. Therefore, Applicants believe that rejections of claims 2, 3, 7 and 16 are moot. Should Examiner persist in the rejection of any of the currently pending claims based on the combination of Szlam in view of White and further in view of Makuch or Szlam in view of White and further in view of Hamscher in view of Makuch, Applicants respectfully request that Examiner (i) remove the finality of the instant Office Action pursuant to M.P.E.P. §§ 706.07(d) or (e) and, (ii) clearly set forth the basis of each claim rejection.

Claims 1-4, 6-8, 10, 15 and 18-21 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and

5-7 of co-pending U.S. Patent Application No. 10/011523 in view of Szlam. As noted above, claims 6, 8, 10, 11, 13, 14 and 19-21 have been canceled thereby rendering the rejection of these claims moot. Regarding the remaining rejection of claims 1-4, 7, 15 and 18, Applicants note that basis for alleging obviousness of these claims is not clearly set forth. In particular, Applicants note that claims 1 and 2 of co-pending U.S. Patent Application No. 10/011523 were canceled by way of amendment in January 2004. As these claims are no longer pending, it is unclear what the basis for the rejection of claims 1-4, 7, 15 and 18 is. Equally important, there has been no specific comparison of any of the claims of co-pending U.S. Patent Application No. 10/011523 to any of the currently pending claims, other than to broadly state that the claims of the co-pending application fail to claim “the use of attitudinal segments”. As noted in M.P.E.P. § 804(II)(B)(1), the basis for making a rejection of obviousness-type double patenting is through a comparison of the claims of co-pending applications. As the instant rejection fails to make any specific comparisons between the claims, Applicants respectfully submit that the rejection is improper and request withdrawal of the rejection. Should Examiner persist in the rejection of any of the currently pending claims based on co-pending U.S. Patent Application No. 10/011523, Applicants respectfully request that Examiner (i) remove the finality of the instant Office Action pursuant to M.P.E.P. §§ 706.07(d) or (e) and, (ii) clearly set forth the basis of each claim rejection. Furthermore, Applicants note that claims 1-4, 7, 15 and 18 have been significantly amended above and included limitations not claimed in co-pending U.S. Patent Application No. 10/011523 nor taught by Szlam. As such, Applicants respectfully submit that claims 1-4, 7, 15 and 18 are in suitable condition for allowance.

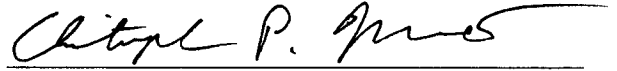
Finally, claims 1, 3, 4, 6-8, 10, 15 and 18-21 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of co-pending U.S. Patent Application No. 10/200262 in view of Szlam. As noted above, claims 6, 8, 10, 11, 13, 14 and 19-21 have been canceled thereby rendering the rejection of these claims moot. Regarding the remaining rejection of claims 1, 3, 4, 15 and 18, Applicants note that basis for alleging obviousness of these claims is not clearly set forth. In particular, Applicants note that claims 1, 3, 6, 8, 9 and 11 of co-pending U.S. Patent Application No. 10/200262 were canceled by way of amendment in November 2005. As these claims are no longer pending, it is unclear what the basis for the rejection of claims 1, 3, 4, 15 and 18 is. Equally important, there has been no specific comparison of any of the claims of co-pending U.S. Patent Application No. 10/200262 to any of the currently pending claims, other than to broadly state that the claims of the co-pending application fail to claim “the use of attitudinal segments”. As noted in M.P.E.P. § 804(II)(B)(1), the basis for making a rejection of obviousness-type double patenting is through a comparison of the claims of co-pending applications. As the instant rejection fails to make any specific comparisons between the claims, Applicants respectfully submit that the rejection is improper and request withdrawal of the rejection. Should Examiner persist in the rejection of any of the currently pending claims based on co-pending U.S. Patent Application No. 10/200262, Applicants respectfully request that Examiner (i) remove the finality of the instant Office Action pursuant to M.P.E.P. §§ 706.07(d) or (e) and, (ii) clearly set forth the basis of each claim rejection. Furthermore, Applicants note that claims 1, 3, 4, 15 and 18 have been significantly amended above and included limitations not claimed in co-pending U.S. Patent Application No.10/200262

nor taught by Szlam. As such, Applicants respectfully submit that claims 1, 3, 4, 15 and 18 are in suitable condition for allowance.

Applicants respectfully submit that the claims are in condition for allowance, and an early Notice of Allowance is earnestly solicited. The Examiner is invited to telephone the below-listed attorney if the Examiner believes that a telephone conference will expedite the prosecution of the application.

Dated: 4/7/06

Respectfully submitted,



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